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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91197754
Party	Plaintiff Wolf-Peter Graeser
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Submission	Motion to Amend Pleading/Amended Pleading
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Date	04/11/2012
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IN THE UNITED STATES PATENT & TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Application No. 76701998 for the mark: LAVATEC  
Published on November 2, 2010

_____	)	
Wolf-Peter Graeser,	)	
	)	
Opposer	)	
	)	Opposition No. 91197754
v.	)	
	)	
Lavatec, Inc. (fka Laundry Acquisition Inc.)	)	
	)	
Applicant	)	
_____		

**MOTION TO FOR LEAVE TO AMEND**

In light of facts revealed during discovery, the decision of the Board dated March 27, 2012, and pursuant to TBMP §507 and Fed. R. Civ. P. 15(a), Wolf Peter Graeser (“Opposer”) moves for leave to amend its Notice of Opposition: (1) to clarify Opposer’s claim under Section 2(d); (2) to clarify Opposer’s claim under Section 43(c); (3) to clarify claims that the Opposed Application is defective and/or fraudulent in its claim of use of the opposed mark in connection with goods and services in International Classes 7 and 11; (4) to clarify certain factual allegations; (5) to address the assignment of the application-in-opposition; (6) to withdraw Opposer’s claim under Section 2(a) of the Trademark Act; and (7) to withdraw Opposer’s claim under Section 2(e)(1).

**BACKGROUND**

Opposer’s First Amended Notice of Opposition, attached hereto as Exhibit A, is based on the following facts:

On March 11, 2010, Applicant filed Trademark Application Serial Number 76701998 (the “Opposed Application”) to register the mark LAVATEC in connection with goods and services in International Classes 7 and 11. Applicant filed the Opposed Application under § 1(a), 15 U.S.C. § 1051(a), on the basis of use in commerce.

During the course of discovery, certain facts were revealed that warrant clarification of the facts and claims in issue. Additionally, during the course of discovery, the Opposed Application was purportedly assigned by Naugatuck Recovery, Inc. (f/k/a Lavatec, Inc.) to Lavatec, Inc. (f/k/a Laundry Acquisition, Inc.) and the Notice of Opposition warrants clarification of the facts and claims as a result of such assignment.

On the basis of these recent revelations, Opposer moves that the attached First Amended Notice of Opposition become the operative pleading in this matter.

### **STANDARD**

Leave to amend a pleading “must be freely given when justice so requires.” TBMP § 507.02; see also Fed. R. Civ. P. 15(a)(2). Amendments to pleadings in trademark oppositions are governed by the Federal Rules of Civil Procedure, where “[u]nder the more liberal standard of Rule 15(a), the trial court should grant leave to file absent a substantial reason for denial, such as undue delay, bad faith, dilatory motive, repeated failure to cure deficiencies with other amendments, futility of the amendment, or undue prejudice to the opposing party.” *Pressure Products Med. Supplies, Inc. v. Greatbatch Ltd.*, No. 2008-1602, 2010 U.S. App. LEXIS 6132, \*22 (Fed. Cir. Mar. 24, 2010).

## DISCUSSION

Opposer has good cause for its Motion for Leave to Amend its Notice of Opposition. Since the proceedings have been suspended several times due to the filing of certain Motions, Opposer's present Motion is timely made and, as explained below, Applicant will suffer no prejudice. The Amended Notice of Opposition seeks to clarify the facts and claims in issue and does not add any new claim that has not already been the subject of discovery between the parties, therefore, as the facts will demonstrate, Opposer's motion is not futile.

### **I. APPLICANT WILL SUFFER NO PREJUDICE IF OPPOSER IS GRANTED LEAVE TO AMEND**

"Prejudice is the 'touchstone of the inquiry under rule 15(a).'" *Pressure Products*, at \*23. "Timing plays a large role in the Board's determination of whether an adverse party would be prejudiced by allowance of an amendment and as a result, long, unexplained delays may render the amendment untimely." *TBC Brands, LLC v. Sullivan*, 2008 TTAB LEXIS 589, \*3 (TTAB 2008) (citing *M. Aron Corp. v. Remington Products, Inc.* 222 U.S.P.Q. 93, 96 (TTAB 1984)). As Applicant can make no colorable claim that it will suffer prejudice as a result of Opposer's amendments, the Board should grant Opposer leave to amend its Notice of Opposition.

Opposer acted promptly in bringing the present Motion. The proceeding was suspended due to the Board's consideration of Applicant's latest Motion to Compel and Opposer had to wait until proceedings were resumed to file this motion. Additionally, the Board never indicated prior to March 27, 2012, that some of Opposer's claims may have been insufficiently pleaded.

Other factual amendments have been recently discovered through the discovery process. In the instant case, Opposer is in Germany and the records involved are over 20-years old and were compiled by Opposer's predecessor in interest, therefore, identifying and exchanging information is a much more time consuming process than would normally be the case. This, coupled with the multiple extended suspensions of this proceeding, have certainly complicated the gathering of evidence and Opposer has only recently received acquired information that warrant an amendment. Too little time has passed for Applicant to claim that it will be unduly prejudiced by an amendment. See, e.g., *TBC Brands*, at \*4 (finding no prejudice to applicant where opposer sought leave to amend "less than four months" after revelation of facts through discovery responses).

In addition, Opposer is more than willing to extend the current trial schedule to extend the discovery period until May 21, 2012, and, therefore to accommodate Applicant. This supports granting leave to amend. Courts often look to the close of discovery as a reference point in determining whether leave to amend will result in undue prejudice. See *FDL, Inc. v. Simmons Co.*, 2003 U.S. Dist. LEXIS 24195, \*39-40 (S.D. Ind. Nov. 17, 2003) (finding no prejudice where discovery remained open, and distinguishing cases where leave is sought after close of discovery or final judgment). Thus, "[a]ny potential prejudice may be ameliorated by the resetting and extension of discovery and trial dates, particularly where the discovery period was still open when the motion was brought." 99 *[cents] Only Stores v. U.S. Dream, Inc.*, 2004 TTAB LEXIS 475, \*5-6 (TTAB Aug. 23, 2004).

Opposer's motion to clarify claims that the Opposed Application is defective

and/or fraudulent in its claim of use of the opposed mark in connection with goods and services in International Classes 7 and 11 will not prejudice Applicant, as the grounds for this cause of action were already stated in the original Notice of Opposition and the matter has already been the subject of discovery. Applicant can demonstrate no reliance or hardship that would affect its ability to defend this action, or otherwise prejudice Applicant.

## **II. OPPOSER’S PROPOSED AMENDMENTS ARE NOT FUTILE**

“‘Futility’ means that the complaint, as amended, would fail to state a claim upon which relief could be granted.” *Glassman v. Computervision Corp.*, 90 F.3d 617, 623 (1st Cir. 1996). “[W]hether or not the moving party can actually prove the allegation(s) sought to be added to a pleading is a matter to be determined after the introduction of evidence at trial or in connection with a proper motion for summary judgment,” TBMP § 507.02, and should not bear on whether the Board should grant leave to amend. Most of Opposer’s amendments are intended to narrow and further clarify its claims, therefore, the amendments have the effect of assisting Applicant defend its claims rather than prejudicing it.

## **III. NO OTHER GROUNDS EXIST FOR DENYING LEAVE TO AMEND**

“[D]elay itself is an insufficient ground to deny amendment.” *Datascope Corp. v. SMEC, Inc.*, 962 F.2d 1043, 1045 (Fed. Cir. 1992). Rather, the delay must be “undue,” *Foman v. Davis*, 371 U. S. 178, 182 (1962), in that it “plac[es] an unwarranted burden on the court.” *Adams v. Gould, Inc.*, 739 F.2d 858, 868 (3d Cir. 1984). Having received material evidence over the last few weeks and the Order of the Board a few days ago, Opposer has not delayed – much less unduly

delayed – in seeking leave to amend. The proceedings have been suspended on two separate occasions for prolonged periods during which Applicant was not permitted to make any filings. As described above, since Opposer is located overseas and the records involved in the case span over 20 years and were from a source other than Opposer, the discovery process and the gathering of written and non-written evidence has been slow. As soon as the discovered facts became clear and the proceedings resumed, this Motion to Amend was filed. It is clear that Opposer has acted promptly in seeking leave to amend its pleadings.

Moreover, Opposer's Motion is not for the purposes of delay, and is not a belated attempt to cure a deficiency. Rather, Opposer's intention is to clarify what it believes to be meritorious claims based on information that has come to light through the discovery process, which is precisely what Rule 15 contemplates. Accordingly, Opposer's actions are timely and are not dilatory.

Finally, Opposer's Motion is made in good faith, and is made on the basis of facts that have only recently been uncovered during discovery.

### **CONCLUSION**

In view of the foregoing, and particularly because (1) Applicant will suffer no prejudice; (2) Opposer's amendments are not futile; and (3) no other grounds exist for denying leave to amend, Opposer respectfully requests that its Motion be GRANTED.

Dated: New York, New York

April 11, 2012

Respectfully submitted.

/s/ Andrea Fiocchi  
Andrea Fiocchi, Esq.  
Sarah E. Tallent, Esq.  
44 Wall Street, 10<sup>th</sup> Fl  
New York, NY 10005  
(212) 710-0970

Attorneys for Opposer,  
Wolf-Peter Graeser

### **CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing Motion for Leave to Amend was served on Applicant at the correspondence address of record by email addressed to:

lind@ip-lawyers.com

On April 11, 2011

By: /s/ Sarah E. Tallent

Exhibit A

**THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark application Serial No.: 76701998

For the mark: LAVATEC

Published in the Official Gazette on November 2, 2010

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Mr. Wolf-Peter Graeser,	)
	)
the "Opposer",	)
	)
v.	) Opposition No. 91197754
	)
Lavatec, Inc.	)
	)
the "Applicant"	)
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**FIRST AMENDED NOTICE OF OPPOSITION**

Wolf-Peter Graeser  
Sonnenbergweg 14  
Flein 74223  
Germany

The above-identified Opposer believes that he will be damaged by registration of the mark shown in the above identified application, and hereby opposes the same.

The grounds for opposition are as follows:

1. Opposer, through its predecessor in interest Lavatec GmbH (f/k/a Lavatec AG) ("Lavatec Germany"), has been engaged in the commercial laundry business since 1986 and has become well and favorably known to members of the public as well as members of the commercial laundry business, for quality commercial laundry equipment products, spare parts and services.
2. Since 1986, and continuing through to the present, Opposer and its predecessor in interest have used the mark "LAVATEC" (the "Mark") in connection with various commercial laundry equipment products manufactured in Germany by Opposer through his company Lavatec Laundry Technology GmbH and its predecessor in interest (the "Products"). The Mark is also used in

connection with advertising, marketing, sales, and services in connection with the Products.

3. Since long prior to the filing date of the application-at-issue, the Mark (which Opposer, through his company Lavatec Laundry Technology GmbH, and its predecessor in interest have circulated on a tremendous amount of products, packaging, advertising, brochures catalogs, etc. throughout the years) has been identified with Opposer through his company Lavatec Laundry Technology GmbH, its predecessor in interest and the Products manufactured by Opposer and its predecessor in interest.

4. Opposer's Products are marketed and sold worldwide and, in the United States, on a nationwide basis, supported by substantial advertising and promotion. Since 1986, the Mark has been used to identify the Products. The nature and quality of such Products has always been controlled by Lavatec Germany and Opposer through his company Lavatec Laundry Technology GmbH.

5. Opposer, through his company Lavatec Laundry Technology GmbH, and its predecessor in interest made it possible for the Mark to acquire substantial customer recognition throughout the United States long prior to the filing date of the application-at-issue; the Mark also enjoys valuable goodwill and has become famous signifying Opposer, through his company Lavatec Laundry Technology GmbH, as the source of products (designed and/or manufactured in Germany) and high-quality services. Lavatec Germany was the owner of the Mark before the Mark was sold to Opposer through his company Lavatec Laundry Technology GmbH.

6. In addition to its prior common law rights in the Mark through his company Lavatec Laundry Technology GmbH, Opposer is also the owner of an international trademark registration for the mark "LAVATEC" in standard characters which was registered with the European Community under Registration Number 008722688 on 08/10/2010, in International Classes 7, 11 and 37.

7. Opposer's registration for the Mark is valid, subsisting, in full force and effect, uncanceled and unrevoked, and serve as evidence of Opposer's exclusive right to use the Mark in commerce on or in connections with the goods and services identified in the registration.

8. Opposer filed an application to register the Mark with the United States Patent and Trademark Office and the application is currently pending under Serial Number: 85138139.

9. Opposer's, through his company Lavatec Laundry Technology GmbH, and its predecessor in interest's use of the Mark has been continuous and it has not

been abandoned. As a result of the long, extensive and widespread use, advertising, promotion and registration of the Mark on and in association with Opposer's goods and services, consumers have become accustomed to associating the Mark with a single source, that is, Opposer, through his company Lavatec Laundry Technology GmbH, and its predecessor in interest.

10. The Applicant seeks to register "LAVATEC" in standard characters as a trademark in International Classes 7 and 11.

11. The Applicant's application was filed by Naugatuck Recovery, Inc. (f/k/a Lavatec, Inc.) ("Original Applicant") and published for opposition on November 2, 2010.

12. Original Applicant was a wholly owned subsidiary of Lavatec GmbH (f/k/a Lavatec AG), a German limited liability company registered with the Commercial Registry of Stuttgart under number HRB 3349 on October 15, 1986 (i.e., Lavatec Germany). Since its incorporation in 1987, one hundred percent of the authorized, issued and outstanding shares of the Original Applicant have been owned by Lavatec Germany. Consequently, since its incorporation, Original Applicant has been a wholly owned subsidiary of Lavatec Germany and is under the direct control of Lavatec Germany.

13. Lavatec Germany is the predecessor in interest of Opposer, the latter having acquired Lavatec Germany's assets, including all of its intellectual property rights worldwide through his company Lavatec Laundry Technology GmbH. At the time of the purchase of Lavatec Germany's assets, Opposer owned 100% of the shares of Lavatec Laundry Technology GmbH. Opposer currently owns 51% of the shares of Lavatec Laundry Technology GmbH and has full control over Lavatec Laundry Technology GmbH.

14. Original Applicant was formed by Lavatec Germany for the mere purpose of serving as Lavatec Germany's U.S. sales office for Products designed and/or manufactured by Lavatec Germany. Original Applicant was at all times under the control of Lavatec Germany, therefore, even assuming for a moment that Original Applicant was the first to use the Mark (which Opposer strongly denies), such use would be attributable to Opposer pursuant to the provisions of 15 U.S.C. §1055. Opposer, through its predecessor in interest, started using the Mark in October 1986. Any use of the mark made by Original Applicant inured to the benefit of its parent company Lavatec Germany, as the party that controlled the nature and quality of the goods and services, therefore, Applicant cannot rely on a date prior to 2011 (when Applicant was incorporated) for the purpose of priority.

15. Original Applicant was never granted a written license to use the Mark, nor was the Mark ever assigned to Original Applicant. At best, Original Applicant had an oral, implied, revocable license to use the Mark in connection with the sale of the Products manufactured by its parent company Lavatec Germany. As a

matter of fact, Original Applicant never attempted to register the Mark until March 2010, and did so without the knowledge or consent of Lavatec Germany.

16. Upon information and belief, neither Original Applicant nor the Applicant manufactures any of the products for which it seeks registration in International Classes 7 and 11 other than “folders, namely, electric clothes folding machines for commercial dry cleaning and laundry purposes”. Upon information and belief, Original Applicant did not commence manufacturing such folding machines until approximately 1991. Upon information and belief, Applicant attempted to manufacture washer extractors, which were designed by Lavatec Germany, on or about 1997, however, the project was unsuccessful and was terminated. The vast majority of the products for which Applicant seeks registration in International Classes 7 and 11 (i.e., “dry-cleaning machines; washing machines for clothing; electric clothing pressing machines for commercial dry cleaning and laundry purposes including shirt press, collar and cuff press, utility press, legger press, drapery press, pants topper, mushroom topper and puff iron”) are not manufactured by Original Applicant or Applicant and, as of the date of the application, many were not even sold by Original Applicant. On the basis of the foregoing, the application-in-issue is itself defective and/or fraudulent since the application states that Original Applicant was using the mark on the listed products since 1987, when in fact Original Applicant never manufactured the claimed products dating back to 1987 nor did it affix the mark to such products dating back to 1987. In 1987 Original Applicant was merely issuing invoices to customers (for convenience purposes) for products designed and manufactured by Opposer’s predecessor in interest in Germany and shipped directly by Opposer’s predecessor in interest from Germany to customers in the U.S. (the products were not even stored at Original Applicant’s place of business).

17. It was Lavatec Germany that first introduced and commenced marketing the Products under the Mark in the United States in 1986 and has continuously sold Products in the United States under the Mark ever since.

18. In furtherance of its interstate commerce, Lavatec Germany then incorporated the Original Applicant, its wholly owned subsidiary, for the purposes of acting as a sales office for Lavatec Germany’s Products in the United States.

19. On May 7, 2009, Lavatec Germany commenced bankruptcy proceedings in Germany.

20. In the course of Lavatec Germany’s bankruptcy proceedings, Opposer purchased the assets of Lavatec Germany through his company Lavatec Laundry Technology GmbH, including without limitation, its land, plant, manufacturing equipment and all of its worldwide intellectual property.

21. During the course of negotiations to purchase the assets of Lavatec Germany, Opposer was given the right file to register the Mark with the European

Trademark Office. The Mark was duly registered by the European Trademark Office and Opposer is the owner of said registration.

22. Opposer has continued the business of Lavatec Germany through his company Lavatec Laundry Technology GmbH and continues to manufacture the Products in Germany and sell them under the Mark worldwide.

23. Opposer, through his company Lavatec Laundry Technology GmbH, is selling the Products in the United States through a new sales office and is no longer supplying the Products to the Original Applicant or Applicant.

24. Original Applicant filed for protection under Chapter XI of the United States Bankruptcy Code in July 2009. Following such filing, Original Applicant filed to register the Mark without the knowledge or consent of Lavatec Germany or its bankruptcy trustee. Upon information and belief, during the aforementioned Chapter XI proceeding, Original Applicant sold certain assets to Applicant and assigned the application-at-issue to Applicant, a newly incorporated corporation under the laws of the State of Connecticut.

25. As a result of the efforts of Lavatec Germany and its successor the Opposer, the Mark has become associated with the Products manufactured by Lavatec Germany and its successor the Opposer (through his company Lavatec Laundry Technology GmbH).

26. At the time Lavatec Germany began using the Mark in interstate commerce in connection with the business of manufacturing and selling commercial laundry equipment, no other entity was utilizing the Mark. Indeed, it was Lavatec Germany that first introduced the products (for which Applicant is now attempting to seek registration in the U.S.) by supplying such products to its own U.S. sales office (i.e., the Original Applicant). Opposer (through its predecessor in interest Lavatec Germany) necessarily sold machines in the U.S. prior to the Original Applicant selling any machines in the U.S., or else the Original Applicant would have had no Products to market and sell (emphasis added).

27. The Applicant is not the owner of the Mark. The Mark has been consistently used to identify the Products manufactured by Opposer, through his Company Lavatec Laundry Technology GmbH, and their predecessor in interest. As a matter of fact, the vast majority of the photographs in the specimen attached to Applicant's original application, show Products manufactured by the Opposer, through his Company Lavatec Laundry Technology GmbH and/or their predecessor in interest, photographed in locations which are either the Opposer's company's facility in Germany or the facilities of Lavatec Germany's clients. Therefore, most of the photographs in the specimen filed by Applicant are not products manufactured by the Applicant (emphasis added).

28. The “LAVATEC” mark sought to be registered by the Applicant is identical, therefore confusingly similar, to the “LAVATEC” mark owned by Opposer.

29. If the Applicant is permitted to use and/or register the “LAVATEC” mark in connection with the products and services described in the application herein opposed, the Opposer will be damaged because the public is likely to be confused as to the source of the products offered by the Opposer and the products offered by the Applicant. The public associates the “LAVATEC” products with products that are made and/or designed in Germany by Opposer, through his company Lavatec Laundry Technology GmbH, and their predecessor in interest. If Applicant was allowed to sell products under the “LAVATEC” mark, the public would be misled into believing that such products are Opposer’s products, when in fact they are not.

30. If the Applicant is permitted to use and/or register the “LAVATEC” mark in connection with the products and services described in the application herein opposed, the Opposer will be damaged because the public is likely to be misled into believing that the products and services offered by the Applicant are endorsed by, sponsored by, or somehow otherwise connected with the Opposer. As a matter of fact, Opposer has already received numerous inquiries from industry operators requesting clarification as to the source of the Products in the United States.

31. If the Applicant is permitted to use and/or register the “LAVATEC” mark in connection with the products and services described in the application herein opposed, the Opposer will be damaged because the Applicant would thereby receive at least a prima facie exclusive right to the use of the “LAVATEC” mark even though this mark is confusingly similar to a mark that the Opposer, through its predecessor in interest, was using in interstate commerce long prior to the date of the Applicant’s application.

32. Registration of the Applicant’s alleged mark, which is the subject to the application-in-opposition, is barred by the provisions of Section 2(d) of the Trademark Act of 1946 because said mark consists of or comprises a mark which so resembles Opposer’s Mark, which have been in use and are also the subject of a prior registration to register marks, as to be likely, when used in connection with the alleged goods of the Applicant to cause confusion, deception or mistake. If allowed to register the mark, Applicant may seek to sell goods of the same type as the Products sold by Opposer under the mark. These goods would be of significantly differing design, characteristics and quality than the Products sold by Opposer which are associated with the “LAVATEC” mark. Allowing Applicant to register Applicant’s alleged mark for use in connection with goods similar to the Products would be akin to allowing Applicant to sell a domestic sedan under the “Porsche” ® trademark and would be likely to deceive consumers (who understand that goods sold under the “LAVATEC” mark are

designed, engineered and/or manufactured in Germany) as to the source and/or origin of the goods.

33. Opposer has priority over Applicant because Opposer's use of the Mark precedes the Applicant's filing date for its application at issue and/or any alleged date of first use in commerce of Applicant's purported mark.

34. Applicant's alleged mark, which is the subject of the application-in-opposition, and Opposer's mark are similar. Indeed, Applicant's claimed mark incorporates Opposer's mark in its entirety.

35. Opposer's Products are related to the products that Applicant markets and sells or intends to market and sell.

36. Accordingly, Applicant's claimed mark "LAVATEC" shown in the application-in-opposition so resembles Opposer's foregoing and previously used and/or registered mark as to be likely to cause confusion, cause mistake or to deceive with consequent injury to the Opposer. The likelihood of confusion, mistake or deception that would also arise from concurrent use and registration of the applied mark with Opposer's use and registration of its Mark is that: (a) persons are likely to believe that Applicant's goods have their source in Opposer or that Applicant is the manufacturer, or (b) Applicant and its goods are a version of Opposer's marks or are in some way legitimately connected or affiliated with, sponsored, approved, endorsed or licensed by Opposer, when, in fact they are not.

37. In view of the foregoing, registration of Applicant's alleged mark is barred by the provisions of Section 2(d) of the Trademark Act of 1946 because the said mark consist or comprises a mark which, when used in connection with the alleged goods of the Applicant, is likely to cause confusion, mistake or deception.

38. Opposer's inherently distinctive Mark became famous prior to the filing date of Applicant's application-in-opposition. Opposer, through its predecessor in interest, started using the Mark in October 1986 and the Mark became famous in the 1980's. Any use of the mark made by Original Applicant inured to the benefit of its parent company Lavatec Germany, as the party that controlled the nature and quality of the goods and services, therefore, Applicant cannot rely on a date prior to 2011 (when Applicant was incorporated) for the purpose of priority. Registration and use of Applicant's claimed mark would likely dilute Opposer's famous and inherently distinctive Mark in violation of 15. U.S.C. §1125(c). Accordingly, the applied-for mark "LAVATEC" is not entitled to registration under 15. U.S.C. §1052(f) and Section 13 of the Lanham Act, 15 U.S.C. §1063.

39. Opposer will be damaged by the issuance of the registration sought by Applicant within the meaning of 15 U.S.C. §1063 because such registration would support and assist Applicant in the confusing, misleading, deceptive and/or

dilutive use of the "LAVATEC" mark and would give the color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of the Opposer.

40. Applicant is not the owner of the mark, therefore, is not entitled to register the mark.

41. By way of multiple communications dated September 2010, Opposer made demand on the Applicant that, among other things, it immediately cease all use of the "LAVATEC" mark and all marks that are similar thereto.

### **PRAYER FOR RELIEF**

Based on the foregoing, the Opposer respectfully requests that Application Number 76701998 be rejected and that registration of the mark therein sought to be registered be denied and refused, and that the Board grant all further relief to Opposer that is necessary and just in these circumstances.

Respectfully submitted,

REINHARDT LLP

Dated April 11, 2012

By: /s/ Andrea Fiocchi  
Andrea Fiocchi, Esq.  
Sarah E. Tallent, Esq.  
44 Wall Street, 10<sup>th</sup> Fl  
New York, NY 10005  
(212) 710-0970

Attorneys for Opposer,  
Wolf-Peter Graeser

### **CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing First Amended Notice of Opposition was served on Applicant at the correspondence address of record by email to:

[lind@ip-lawyers.com](mailto:lind@ip-lawyers.com)

On April 11, 2012.

By: /s/ Sarah E. Tallent

**THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark application Serial No.: 76701998

For the mark: LAVATEC

Published in the Official Gazette on November 2, 2010

Mr. Wolf-Peter Graeser,

the “Opposer”,

**V.**

91197754

Lavatec, Inc.

the “Applicant”

) — Opposition No.

# **FIRST AMENDED NOTICE OF OPPOSITION**

Wolf-Peter Graeser  
Sonnenbergweg 14  
Flein 74223  
Germany

The above-identified Opposer believes that he will be damaged by registration of the mark shown in the above identified application, and hereby opposes the same.

The grounds for opposition are as follows:

1. Opposer, through its predecessor in interest Lavatec GmbH (f/k/a Lavatec AG)<sup>7</sup> ("Lavatec Germany"), has been engaged in the commercial laundry business since 1986 and has become well and favorably known to members of the public as well as members of the commercial laundry business, for quality commercial laundry equipment products, spare parts and services.

2. Since 1986, and continuing through to the present, Opposer and its predecessor in interest have used the mark “LAVATEC” (the “Mark”) in connection with various commercial laundry equipment products manufactured in Germany by Opposer through his company Lavatec Laundry Technology GmbH and its predecessor in interest (the “Products”). The Mark is also used in

connection with advertising, marketing, sales, and services in connection with the Products.

3. Since long prior to the filing date of the application-at-issue, the Mark (which Opposer, through his company Lavatec Laundry Technology GmbH, and its predecessor in interest have circulated on a tremendous amount of products, packaging, advertising, brochures catalogs, etc. throughout the years) has been identified with Opposer through his company Lavatec Laundry Technology GmbH, its predecessor in interest and the Products manufactured by Opposer and its predecessor in interest.

4. Opposer's Products are marketed and sold worldwide and, in the United States, on a nationwide basis, supported by substantial advertising and promotion. Since 1986, the Mark has been used to identify the Products. The nature and quality of such Products has always been controlled by Lavatec Germany and Opposer through his company Lavatec Laundry Technology GmbH.

5. Opposer, through his company Lavatec Laundry Technology GmbH, and its predecessor in interest made it possible for the Mark to acquire substantial customer recognition throughout the United States long prior to the filing date of the application-at-issue; the Mark -also enjoys valuable goodwill and has become famous signifying Opposer, through his company Lavatec Laundry Technology GmbH, as the source of products (designed and/or manufactured in Germany) and high-quality services. Lavatec Germany was the owner of the Mark before the Mark was sold to Opposer through his company Lavatec Laundry Technology GmbH.

6. In addition to its prior common law rights in the Mark through his company Lavatec Laundry Technology GmbH, Opposer is also the owner of an international trademark registration for the mark "LAVATEC" in standard characters which was registered with the European Community under Registration Number 008722688 on 08/10/2010, in International Classes 7, 11 and 37.

7. Opposer's registration for the Mark is valid, subsisting, in full force and effect, uncanceled and unrevoked, and serve as evidence of Opposer's exclusive right to use the Mark in commerce on or in connections with the goods and services identified in the registration.

8. Opposer filed an application to register the Mark with the United States Patent and Trademark Office and the application is currently pending under Serial Number: 85138139.

9. Opposer's, through his company Lavatec Laundry Technology GmbH, and its predecessor in interest's use of the Mark has been continuous and it has not

been abandoned. As a result of the long, extensive and widespread use, advertising, promotion and registration of the Mark on and in association with Opposer's goods and services, consumers have become accustomed to associating the Mark with a single source, that is, the Opposer, through his company Lavatec Laundry Technology GmbH, and its predecessor in interest.

10. The Applicant seeks to register "LAVATEC" in standard characters as a trademark in International Classes 7 and 11.

11. The Applicant's application was filed by Naugatuck Recovery, Inc. (f/k/a Lavatec, Inc.) ("Original Applicant") and published for opposition on November 2, 2010.

12. Original Applicant ~~is~~was a wholly owned subsidiary of Lavatec GmbH (f/k/a Lavatec AG), a German limited liability company registered with the Commercial Registry of Stuttgart under number HRB 3349 on October 15, 1986 ~~("i.e., Lavatec Germany").~~ Since its incorporation in 1987, one hundred percent of the authorized, issued and outstanding shares of the Original Applicant have been owned by Lavatec Germany. Consequently, since its incorporation, Original Applicant has been a wholly owned subsidiary of Lavatec Germany and is under the direct control of Lavatec Germany.

13. Lavatec Germany is the predecessor in interest of Opposer, the latter having acquired Lavatec Germany's assets, including all of its intellectual property rights worldwide through his company Lavatec Laundry Technology GmbH. At the time of the purchase of Lavatec Germany's assets, Opposer owned 100% of the shares of Lavatec Laundry Technology GmbH. Opposer currently owns 51% of the shares of Lavatec Laundry Technology GmbH and has full control over Lavatec Laundry Technology GmbH.

14. Original Applicant was formed by Lavatec Germany for the mere purpose of serving as Lavatec Germany's U.S. sales office for Products designed and/or manufactured by Lavatec Germany. Original Applicant was at all times under the control of Lavatec Germany, therefore, even assuming for a moment that Original Applicant was the first to use the Mark (which Opposer strongly denies), such use would be attributable to Opposer pursuant to the provisions of U.S.C. §105515 U.S.C. §1055. Opposer, through its predecessor in interest, started using the Mark in October 1986. Any use of the mark made by Original Applicant inured to the benefit of its parent company Lavatec Germany, as the party that controlled the nature and quality of the goods and services, therefore, Applicant cannot rely on a date prior to 2011 (when Applicant was incorporated) for the purpose of priority.

15. Original Applicant was never granted a written license to use the Mark, nor was the Mark ever assigned to Original Applicant. At best, Original Applicant had

an oral, implied, revocable license to use the Mark in connection with the sale of the Products manufactured by its parent company Lavatec Germany. As a matter of fact, Original Applicant never attempted to register the Mark until March 2010, and did so without the knowledge or consent of Lavatec Germany.

16. Upon information and belief, neither Original Applicant nor the Applicant ~~does not manufacture~~manufactures any of the products for which it seeks registration in International Classes 7 and 11 other than “folders, namely, electric clothes folding machines for commercial dry cleaning and laundry purposes”. Upon information and belief, Original Applicant did not commence manufacturing such folding machines until approximately 1991. Upon information and belief, Applicant attempted to manufacture washer extractors, which were designed by Lavatec Germany, on or about 1997, however, the project was unsuccessful and was terminated. The vast majority of the products for which Applicant seeks registration in International Classes 7 and 11 (i.e., “dry-cleaning machines; washing machines for clothing; electric clothing pressing machines for commercial dry cleaning and laundry purposes including shirt press, collar and cuff press, utility press, legger press, drapery press, pants topper, mushroom topper and puff iron”) are not manufactured by ~~Applicant and, as of the date of the application, many are not even sold by Applicant.~~Original Applicant or Applicant and, as of the date of the application, many were not even sold by Original Applicant. On the basis of the foregoing, the application-in-issue is itself defective and/or fraudulent since the application states that Original Applicant was using the mark on the listed products since 1987, when in fact Original Applicant never manufactured the claimed products dating back to 1987 nor did it affix the mark to such products dating back to 1987. In 1987 Original Applicant was merely issuing invoices to customers (for convenience purposes) for products designed and manufactured by Opposer’s predecessor in interest in Germany and shipped directly by Opposer’s predecessor in interest from Germany to customers in the U.S. (the products were not even stored at Original Applicant’s place of business).

17. It was Lavatec Germany that first introduced and commenced marketing the Products under the Mark in the United States in 1986 and has continuously sold Products in the United States under the Mark ever since.

18. In furtherance of its interstate commerce, Lavatec Germany then incorporated the Original Applicant, its wholly owned subsidiary, for the purposes of acting as a sales office for Lavatec Germany’s Products in the United States.

19. On May 7, 2009, Lavatec Germany commenced bankruptcy proceedings in Germany.

20. In the course of Lavatec Germany’s bankruptcy proceedings, Opposer purchased the assets of Lavatec Germany through his company Lavatec

Laundry Technology GmbH, including without limitation, its land, plant, manufacturing equipment and all of its worldwide intellectual property.

21. During the course of negotiations to purchase the assets of Lavatec Germany, Opposer ~~then filed~~was given the right file to register the Mark with the European Trademark Office. The Mark was duly registered by the European Trademark Office and Opposer is the owner of said registration.

22. Opposer has continued the business of Lavatec Germany through his company Lavatec Laundry Technology GmbH and continues to manufacture the Products in Germany and sell them under the Mark worldwide.

23. ~~Opposer~~Opposer, through his company Lavatec Laundry Technology GmbH, is selling the Products in the United States through a new sales office and is no longer supplying the Products to the Original Applicant or Applicant.

24. Original Applicant filed for protection under Chapter XI of the United States Bankruptcy Code in July 2009. Following such filing, Original Applicant filed to register the Mark without the knowledge or consent of Lavatec Germany or its bankruptcy trustee. Upon information and belief, during the aforementioned Chapter XI proceeding, Original Applicant sold certain assets to Applicant and assigned the application-at-issue to Applicant, a newly incorporated corporation under the laws of the State of Connecticut.

25. As a result of the efforts of Lavatec Germany and its successor the Opposer, the Mark has become associated with the Products manufactured by Lavatec Germany and its successor the ~~Opposers~~Opposer (through his company Lavatec Laundry Technology GmbH).

26. At the time Lavatec Germany began using the Mark in interstate commerce in connection with the business of manufacturing and selling commercial laundry equipment, no other entity was utilizing the Mark. Indeed, it was Lavatec Germany that first introduced the products (for which Applicant is now attempting to seek registration in the U.S.) by supplying such products to its own U.S. sales office (i.e., the Original Applicant). Opposer (through its predecessor in interest Lavatec Germany) necessarily sold machines in the U.S. prior to the Original Applicant, selling any machines in the U.S., or else the Original Applicant would have had no Products to market and sell. (emphasis added).

27. The Applicant is not the owner of the Mark. The Mark has been consistently used to identify the Products manufactured by Opposer, through his Company Lavatec Laundry Technology GmbH, and ~~its~~their predecessor in interest. As a matter of fact, the vast majority of the photographs in the specimen attached to Applicant's original application, show Products manufactured by the Opposer, through his Company Lavatec Laundry Technology GmbH and/or their predecessor in interest, photographed in locations which are either the Opposer's

company's facility in Germany or the facilities of Lavatec Germany's clients. Therefore, most of the photographs in the specimen filed by Applicant are not products manufactured by the Applicant- (emphasis added).

28. The "LAVATEC" mark sought to be registered by the Applicant is identical, therefore confusingly similar, to the "LAVATEC" mark owned by Opposer.

29. If the Applicant is permitted to use and/or register the "LAVATEC" mark in connection with the products and services described in the application herein opposed, the Opposer will be damaged because the public is likely to be confused as to the source of the products offered by the Opposer and the products offered by the Applicant. The public associates the "LAVATEC" products with products that are made and/or designed in Germany by Opposer, through his company Lavatec Laundry Technology GmbH, and their predecessor in interest. If Applicant was allowed to sell products under the "LAVATEC" mark, the public would be misled into believing that such products are Opposer's products, when in fact they are not.

30. If the Applicant is permitted to use and/or register the "LAVATEC" mark in connection with the products and services described in the application herein opposed, the Opposer will be damaged because the public is likely to be misled into believing that the products and services offered by the Applicant are endorsed by, sponsored by, or somehow otherwise connected with the Opposer. As a matter of fact, Opposer has already received numerous inquiries from industry operators requesting clarification as to the source of the Products in the United States.

31. If the Applicant is permitted to use and/or register the "LAVATEC" mark in connection with the products and services described in the application herein opposed, the Opposer will be damaged because the Applicant would thereby receive at least a prima facie exclusive right to the use of the "LAVATEC" mark even though this mark is confusingly similar to a mark that the Opposer, through its predecessor in interest, was using in interstate commerce long prior to the date of the Applicant's application.

32. Registration of the Applicant's alleged mark, which is the subject to the application-in-opposition, is barred by the provisions of Section 2(d) of the Trademark Act of 1946 because said mark consists of or comprises a mark which so resembles Opposer's Mark, which have been in use and are also the subject of a prior registration to register marks, as to be likely, when used in connection with the alleged goods of the Applicant to cause confusion, deception or mistake. If allowed to register the mark, Applicant may seek to sell goods of the same type as the Products sold by Opposer under the mark. These goods would be of significantly differing design, characteristics and quality than the Products sold by Opposer which are associated with the "LAVATEC" mark. Allowing Applicant to register Applicant's alleged mark for use in connection with

goods similar to the Products would be akin to allowing Applicant to sell a domestic sedan under the "Porsche" ® trademark and would be likely to deceive consumers (who understand that goods sold under the "LAVATEC" mark are designed, engineered and/or manufactured in Germany) as to the source and/or origin of the goods.

33. Opposer has priority over Applicant because Opposer's use of the Mark precedes the Applicant's filing date for its application at issue and/or any alleged date of first use in commerce of Applicant's purported mark.

34. Applicant's alleged mark, which is the subject of the application-in-opposition, and Opposer's mark are similar. Indeed, Applicant's claimed mark incorporates Opposer's mark in its entirety.

35. Opposer's Products are related to the products that Applicant markets and sells or intends to market and sell.

36. Accordingly, Applicant's claimed mark "LAVATEC" shown in the application-in-opposition so resembles Opposer's foregoing and previously used and/or registered mark as to be likely to cause confusion, cause ~~misstate~~mistake or to deceive with consequent injury to the Opposer. The likelihood of confusion, mistake or deception that would also arise from concurrent use and registration of the applied mark with Opposer's use and registration of its Mark is that: (a) persons are likely to believe that Applicant's goods have their source in Opposer or that Applicant is the manufacturer, or (b) Applicant and its goods are a version of Opposer's marks or are in some way legitimately connected or affiliated with, sponsored, approved, endorsed or licensed by Opposer, when, in fact they are not.

37. In view of the foregoing, registration of Applicant's alleged mark is barred by the provisions of Section 2(d) of the Trademark Act of 1946 because the said mark consist or comprises a mark which, when used in connection with the alleged goods of the Applicant, is likely to cause confusion, mistake or deception.

38. Opposer's inherently distinctive Mark became famous prior to the filing date of Applicant's application-in-opposition. Opposer, through its predecessor in interest, started using the Mark in October 1986 and the Mark became famous in the 1980's. Any use of the mark made by Original Applicant inured to the benefit of its parent company Lavatec Germany, as the party that controlled the nature and quality of the goods and services, therefore, Applicant cannot rely on a date prior to 2011 (when Applicant was incorporated) for the purpose of priority. Registration and use of Applicant's claimed mark would likely dilute Opposer's famous and inherently distinctive Mark in violation of 15. U.S.C. §1125(c). Accordingly, the applied-for mark "LAVATEC" is not entitled to registration under 15. U.S.C. §1052(f) and Section 13 of the Lanham Act, 15 U.S.C. §1063.

39. Opposer will be damaged by the issuance of the registration sought by Applicant within the meaning of 15 U.S.C. §1063 because such registration would support and assist Applicant in the confusing, misleading, deceptive and/or dilutive use of the "LAVATEC" mark and would give the color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of the Opposer.

40. Applicant is not the owner of the mark, therefore, is not entitled to register the mark.

41. By way of multiple communications dated September 2010, Opposer made demand on the Applicant that, among other things, it immediately cease all use of the "LAVATEC" mark and all marks that are similar thereto.

### PRAYER FOR RELIEF

Based on the foregoing, the Opposer respectfully requests that Application Number 76701998 be rejected and that registration of the mark therein sought to be registered be denied and refused, and that the Board grant all further relief to Opposer that is necessary and just in these circumstances.

Respectfully submitted,

REINHARDT LLP

Dated ~~December 7, 2010~~ April 11, 2012

By:

/s/ Andrea Fiocchi

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## CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing First Amended Notice of Opposition was served on Applicant at the correspondence address of record by ~~express courier, in an envelope with sufficient postage addressed~~email to:

~~LAVATEC, INC.  
300 Great Hill Road  
Naugatuck, CT 06770~~

~~On December 7, 2010.~~ \_\_\_\_\_ By: \_\_\_\_\_

~~lind@ip-lawyers.com~~

~~On April 11, 2012.~~ \_\_\_\_\_

~~By: /s/ Sarah E. Tallent, Esq.~~